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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,138	04/08/2005	Werner Jaeger	127-75824	1950
23643 7590 03/03/2009 BARNES & THORNBURG LLP 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204				
EXAMINER				
MULLIS, JEFFREY C				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
03/03/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

indocket@btlaw.com

# Office Action Summary

Application No.

10/509,138

Applicant(s)

JAEGER ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3-16, 19, 20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-16, 19, 20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Claims 19 and 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed did not disclose "weight average" molar masses and therefore the term "weight average" is new matter.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-16, 19, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neff et al. (US 5882525) in view of (US 4713431, admission at page 1, lines 29-33 of the specification).

Patentees disclose a polymer which may contain applicants monomers "I" at column 4, lines 47-58 and 4-80 parts per million of a "branching agent" (see the paragraph bridging columns 3 and 4) such as PEGDMA of molecular weight of 600 (see experiments 10-11 in column 9). The materials may be used as flocculants agents for effluent in the treatment of sludges at column 1, lines 10-39.

There are no examples of a material produced by using patentees diallyl ammonium compounds in combination with applicants amounts of PEG dimethacrylate although patentees disclose that applicants amounts of branching agent which include PEGDMA

may be used in amounts encompassing applicants' in combination with monomers including applicants. Hence it would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention to select applicants components in applicants amounts from the disclosure of the patent in the expectation of adequate results absent any showing of surprising or unexpected results.

Patentees do not appear to disclose inverse emulsion polymerization as required by certain dependent claims. However page 1, lines 29-33 of applicants specification discloses that the advantage of inverse emulsion polymerization is known in the art for increasing molecular weights of flocculating polymers. Hence use of inverse emulsion polymerization would have been obvious to a practitioner having an ordinary skill in the art at the time of the invention to confer the advantage of increased molecular weight absent any showing of surprising or unexpected results.

Applicant's arguments filed 11-17-08 have been fully considered but they are not persuasive.

It is immaterial to patentability that applicants claims may recite a broad range of branching agent "from hundredths of a percent to as much as 20 percent" as argued by applicants. Increasing the scope of an application claim does not make that claim more patentable. While it may be true that there is not a large amount of overlap between the range of patentees' branching agent and applicants amounts of units "II", end points can properly be said to be disclosed by a reference and therefore when an end point falls within a claimed range it cannot be said that the breadth of the range disclosed by the reference detracts from any case of prima facie case of obviousness where picking and

choosing from disclosure is require. Applicants have in fact not selected a narrow range from a broad range in the prior art which subsumes their own range but have selected a range encompassing an end point disclosed by the prior art. There is no basis in law for applicants position that applicants entire range has to be disclosed or suggested by the prior art. In fact only a single point or single specie of a claim reciting a range or genus respectively need be taught or suggested by the prior art to render a claim obvious. It is not the position of the examiner that any example of the references relied upon disclose all elements of the invention as it is not the position of the examiner that any reference relied upon anticipates applicants claims. It is immaterial that the prior art uses chain transfer agent since the instant claims do not exclude its use and 0.03% branching agent is within the metes and bounds of the claims. It is immaterial how high applicants highest level of branching agent is so long as an amount of branching agent within the claimed range is disclosed by the prior art. Applicants argue unexpected results but unexpected results must be with the closest prior art, MPEP 716 and no examples which are properly comparative to Neff have been presented by applicants. Applicants renew their arguments regarding chain transfer agents but as applicants have removed the language "consisting of" from the claims the examiner's previous arguments regarding chain transfer agents (as incorrectly characterized by applicants in the last complete paragraph of page 11 of their remarks) are immaterial to the claims as presently of record. The fact that applicants claims do not require chain transfer agents is immaterial so long as the instant claims do not require its use. A claim encompassing obvious embodiments as well as obvious ones is still obvious. The claims define the

invention and use of chain transfer agents is not excluded. Applicants argue that Bhattacharyya does not teach various elements of the claims. However Bhattacharyya has only been used for patentees teaching of inverse emulsion polymerization.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis, M-F, 9-5 pm at telephone number 571 272 1075.

Jeffrey C. Mullis  
Primary Examiner  
Art Unit 1796

JCM

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2-26-09

/Jeffrey C. Mullis/

Primary Examiner, Art Unit 1796